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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,113	06/23/2003	Eugene F. Young	4847	2441
22896	7590	04/14/2006	EXAMINER	
MILA KASAN, PATENT DEPT. APPLIED BIOSYSTEMS 850 LINCOLN CENTRE DRIVE FOSTER CITY, CA 94404			HYUN, PAUL SANG HWA	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,113

Applicant(s)

YOUNG ET AL.

Examiner

Paul S. Hyun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to a cap comprising a lens for sealing sample wells, classified in class 435, subclass 305.4.
- II. Claims 19-26, drawn to a microcard comprising a first member and a second member that define sample chambers having lenses, classified in class 422, subclass 82.09.
- III. Claims 27-29, drawn to stackable sample well strips, classified in class 422, subclass 82.09.
- IV. Claims 30-34, drawn to a method for testing a biological sample by collecting light emitted by the sample, classified in class 436, subclass 805.
- V. Claims 35 and 36, drawn to a sample well tray having well bottoms made out of a lens, classified in class 422, subclass 82.09.
- VI. Claim 37, drawn to a system comprising sample wells, a light source and a detector for analyzing a sample, classified in class 422, subclass 82.09.

- 1. Inventions I, II, III, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).

Inventions I and II are directed toward a cap for sealing sample wells and a microcard, respectively. The two inventions are not capable of being used together because the claims of Group II does not recite a cap for sealing sample wells. It is also evident that the two inventions have different designs, modes of operation and effects.

Inventions I and III are directed toward a cap for sealing sample wells and a stackable apparatus comprising sample wells wherein the side of the wells are made out of lens, respectively. Because the apparatus is stackable, it does not require a cap for sealing the sample wells. It is also evident that the two inventions have different designs, modes of operation and effects.

Inventions I and V are directed toward a cap for sealing sample wells and an apparatus comprising sample wells wherein the bottom of each well is closed off by a lens. Because the cap of Invention I is intended to cap the tops of sample wells, the two inventions are not capable of being used together. It is also evident that the two inventions have different designs, modes of operation and effects.

Inventions I and VI are directed toward a cap for sealing sample wells and a system for analyzing samples comprising sample wells wherein a lens comprises the bottom of each well. Because the cap of Invention I is intended to cap the tops of sample wells, the two inventions are not capable of being used together. It is also evident that the two inventions have different designs, modes of operation and effects.

Inventions II and III are directed toward two separate embodiments of sample holding apparatuses. The apparatus of Invention II comprises a plurality of chambers defined between two members wherein a lens is adapted to collect light emitted by the

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sample whereas the apparatus of Invention III comprises a stackable strip of sample wells wherein the sides of the wells comprise lenses for transmitting light out of the sample wells. It is evident that the two inventions have different designs, modes of operation and effects.

Inventions II and V are directed toward two separate embodiments of sample holding apparatuses. The apparatus of Invention II comprises a plurality of chambers defined between two members whereas the apparatus of Invention V comprises a plurality of chambers wherein the bottom of the wells comprise lenses. It is evident that the two inventions have different designs, modes of operation and effects.

Inventions II and VI are directed toward a sample holding apparatus and a system for analyzing samples, respectively. The sample holding apparatus comprises a plurality of chambers defined between two members whereas the system comprises a plurality of chambers wherein the bottom of the wells comprise lenses. It is evident that the two inventions have different designs, modes of operation and effects.

Inventions III and V are directed toward two separate embodiments of sample holding apparatuses. The apparatus of Invention III comprises a stackable strip of sample wells wherein the sides of the wells comprise lenses for transmitting light out of the sample wells whereas the apparatus of Invention V comprises a plurality of chambers wherein the bottom of the wells comprise lenses for collecting the light emitted by the sample. It is evident that the two inventions have different designs, modes of operation and effects.

Inventions III and VI are directed toward a sample holding apparatus and a system for analyzing samples, respectively. The sample holding apparatus comprises a stackable strip of sample wells wherein the sides of the wells comprise lenses for transmitting light out of the sample wells whereas the system comprises a plurality of chambers wherein the bottom of the wells comprise lenses. It is evident that the two inventions have different designs, modes of operation and effects.

2. Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the lens can be used to magnify an object for obtaining a better image of the object.

3. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the two inventions recite two separate embodiments of sample holding apparatuses. The different inventions are not capable of being used together since the apparatus of Invention II does not comprise a cap having a lens. It is also evident that the two inventions have different designs, modes of operation and effects.

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4. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the two inventions recite two separate embodiments of sample holding apparatuses. The different inventions are not capable of being used together since the apparatus of Invention III does not comprise a cap having a lens. It is also evident that the two inventions have different designs, modes of operation and effects.

5. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the two inventions recite two separate embodiments of sample holding apparatuses. The different inventions are not capable of being used together since the apparatus of Invention V does not comprise a cap having a lens. It is also evident that the two inventions have different designs, modes of operation and effects.

6. Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the two inventions recite two separate embodiments of sample holding apparatuses. The different inventions are not capable of being used together since the system of Invention

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VI does not comprise a cap having a lens. It is also evident that the two inventions have different designs, modes of operation and effects.

7. Inventions V and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because wells having a lens at the top of each well instead of at the bottom of the well can be used in the system. The subcombination has separate utility such as holding samples for storage.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

A telephone call was made to Phil Makrogiannis on 04/11/06 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSH
4/11/06



**YELENA GAKH
PRIMARY EXAMINER**